

REMARKS

This paper is in response to the Office Communication mailed May 4, 2004 asserting that the reply filed on February 2, 2004 was not fully responsive to the prior Office Action dated September 2, 2003. Claims 2, 62-65, 69 and 70 are pending. Claims 71-80 were added in the prior paper of February 2, 2004 to further clarify the novel features of the present invention. In response to the Office Communication, the newly added claims find support in the specification and, thus, no new matter has been added. Specifically, claim 71 finds support on page 7, lines 16-25, page 16, lines 15-23 and page 2, line 31 to page 3, line 4 of the specification. Claim 72 finds support on page 10, lines 21 to page 12, line 3 of the specification. Claim 73 finds support on page 4, lines 6-8 and page 10, lines 4-20 of the specification. Claim 74 finds support on page 9, lines 10-20 of the specification. Claims 75 and 76 find support on page 13, line 15 to page 14, line 10 of the specification. Claim 77 finds support on page 7, line 27 to page 8, line 2 of the specification. Claims 78-80 find support on page 10, line 21 to page 11, line 17 of the specification. Accordingly, Applicant respectfully submits that all claims are in condition for allowance.

Applicant respectfully requests further examination and reconsideration of the application in view of the following remarks.

1. Collart (U.S. Publication No. US 2002/0091575 A1)

The Office Communication has requested specific support in the specification of patentability of the newly presented claims, namely, claims 71-80, and how claims 71-80 distinguish over previously applied references. Claims 1, 2, 10 and 11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. US 2002/0091575 A1 to Collart ("Collart"). In addition to presenting arguments in the previous paper of February 2, 2004, which arguments are incorporated herewith, Applicant

respectfully submits that claims 71-80 are distinguishable over Collart for at least the reasons set forth below.

Independent claim 71 recites a DVD having “a first digital work” and “commercial” that includes “a first outcome, which inhibits said first digital work” and “a second outcome, which displays said first digital work.”

Independent claims 72 and 78 recite a method of advertising using a DVD comprising the steps of "providing an advertisement including at least one clue," "displaying said advertisement," "providing a game play if said at least one response meets a predetermined condition," "employing said game play having one of a first outcome and a second outcome," and "selectively awarding a prize based upon the first outcome of said game play and displaying a digital work based upon the second outcome of said game play."

In contrast, Collart merely describes a method and device for tracking usage of a recording medium based on an identifier that is stored on the recording medium. The identifier may correspond to an individual user of the recording medium (paragraph 0017). Moreover, an identifier can be selected at random where “a prize is issued, in lottery fashion to a person associated with the identifier” (paragraph 0021). Additionally, Collart merely describes the use of a DVD in a promotional marketing effort in the form of a lottery, where a “DVD identifier can be used to provide an award to a user of a certain disc” (paragraph 0247).

Collart therefore lacks the “first digital work” and “commercial” called for by claim 71, and the "digital work" and "advertisement" called for in claims 72 and 78. Applicant's claims 71, 72 and 78 call for two distinct digital works and two distinct outcomes, with one of the outcomes associated with displaying of a digital work. In contrast, in Collart, the outcomes are associated with an identifier, not with the digital work itself. The outcomes of

Applicant's claim 71 are not limited to whether the user of the DVD is associated with "the selected DVD identifier," as in Collart (paragraph 0247).

Furthermore, Applicant's claims 72 and 78 also calls for display of "at least one clue" and receiving a response in association with the method of advertisement. Collart does not have the present invention in mind and, instead, merely describes a method of tracking usage of a storage medium. Specifically, Collart does not disclose "providing an advertisement including at least one clue" or "providing a game play if [] at least one response meets [a] predetermined condition," as recited in claims 72 and 78.

As such, Collart fails to teach or fairly suggest the claimed invention. Therefore, claims 71, 72 and 78 are in condition for allowance. Claims 73-77 and 79-80 depend on claims 72 and 78, respectively, and are therefore also in condition for allowance.

Reconsideration is respectfully requested.

2. Simpson (U.S. Publication No. US 2001/0049627 A1)

The Office Communication has requested specific support in the specification of patentability of the newly presented claims, namely, claims 71-80, and how claims 71-80 distinguish over previously applied references. Claims 1, 2, 10, 11 and 62 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. US 2001/0049627 A1 to Simpson ("Simpson"). In addition to presenting arguments in the previous paper of February 2, 2004, which arguments are incorporated herewith, Applicant respectfully submits that claims 71-80 are distinguishable over Simpson for at least the reasons set forth below.

As described above, Applicant's independent claim 71 recites a DVD having "a first digital work" and "commercial" that includes "a first outcome, which inhibits said first digital work" and "a second outcome, which displays said first digital work." Independent claims 72

and 78 recite a method of advertising using a DVD comprising the steps of "providing an advertisement including at least one clue," "displaying said advertisement," "providing a game play if said at least one response meets a predetermined condition," "employing said game play having one of a first outcome and a second outcome," and "selectively awarding a prize based upon the first outcome of said game play and displaying a digital work based upon the second outcome of said game play."

In contrast, Simpson merely describes a method of "distributing electronic coupons that includes the presentation of multimedia information" (paragraph 0017). Additionally, Simpson requires the use of an access code or authorization in order to procure or view any particular coupons (paragraphs 0037, 0042, 0072-77). Authorization in Simpson may be obtained when a user give actual information regarding, for example, the user's geographical area, gender, age, hobbies, interests, occupation or any other information which may be useful in customizing the coupons or discount offers (paragraphs 0072-77).

Claim 71 recites to the use of a commercial that includes a first outcome, inhibiting the first digital work, and a second outcome, displaying the first digital work. In contrast, Simpson does not disclose or suggest the use of commercials in the way contemplated by the present invention. As stated in the paper submitted February 2, 2004, commercials and the associated methods and systems of applicant's claims are distinguishable from coupons, as commercials impart brand image and heightened awareness through the combined use of sight, color, sound and motion (often evoking strong emotions from viewers) as opposed to the static display of a coupon that may merely be a ticket that entitles the bearer to certain benefits, such as a cash refund or a discount on a purchase. Furthermore, commercials have a certain time duration, such as the general thirty-second television clip, in which to convey the goods, an intended image, a secondary message, etc. The content of coupons, on the

contrary, are immediately perceived. Moreover, many companies spending considerable amounts of time and money in producing and presenting commercials. As such, commercials represent substantial investments for companies.

Additionally, even assuming arguendo that coupons are in the least bit related to commercials, the use of coupons as described in Simpson does not have a first outcome or second outcome associated with the use. Rather, the digital works described in Simpson appear to have associated outcomes. Simpson describes use of a trivia game, for example, associated with multiple outcomes, one of which is presenting a coupon with a "discount offer" upon "achieving a record high score" (paragraph 0074). On the contrary, Applicant's invention uses the commercial as being the conduit through which a digital work is displayed, not the other way around.

Claims 72 and 78 address needs particular to viewer-acceptance of and attention to advertisements. For example, a commercial's message and content may not be fully displayed if a user fast-forwards through the commercial once the commercial begins or skips the commercial entirely. Further, an advertisement may not be fully appreciated for the product or service being advertised though a cursory and momentary glance by an audience. Thus, claims 72 and 78 address this problem by including clues with advertisements and related questions in order to prolong the exposure of such an advertisement to and perhaps pique the interest of an audience.

Simpson does not recognize the problem or the source of the problem itself, and thus does not address it. Simpson merely describes the use of multimedia content to draw a user to engage the CD-ROM to obtain exposure of coupons; it does not teach or suggest the inherent problems associated with the display of advertisements or the use of clues and questions related to an advertisement to address this problem. Simpson merely discloses a system and method whereby a user inputs marketing-related biographic and demographic

information and, in turn, receives a collection of coupons that may be customized according to the user's preferences.

As such, Simpson fails to teach or fairly suggest the claimed invention. Therefore, claims 71, 72 and 78 are in condition for allowance. Claims 73-77 and 79-80 depend on claims 72 and 78, respectively, and are therefore also in condition for allowance. Reconsideration is respectfully requested.

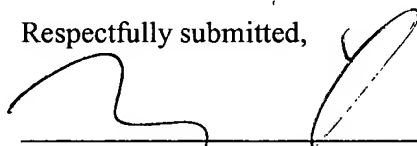
CONCLUSION

It is respectfully submitted that all claims in the application are now allowable. Reconsideration and withdrawal of all rejections are respectfully requested. Favorable notice to this effect and early Notice of Allowance are earnestly solicited.

Should the Examiner have any questions and in order to expedite prosecution of this Application, the Examiner is encouraged to contact the undersigned directly.

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Respectfully submitted,


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